

AF/2700



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(MBHB Case No. 00-591)

In re Application of: )  
Edward M. Housel )  
Serial No.: 09/692,645 ) Group Art Unit: 2624  
Filed: October 19, 2000 ) Examiner: King Y. Poon  
For: Method of Generating Printer Setup )  
Instructions )

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Mail Stop AF  
Commission for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

In regard to the above identified application:

1. We are transmitting herewith the attached papers for the above-identified patent application:

- ☒ Reply to Examiner's Answer
- ☒ Return Receipt Postcard

2. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2490. A duplicate copy of this sheet is enclosed.

3. **CERTIFICATE OF MAILING UNDER 37 CFR § 1.8:** The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1 herein-above, are being deposited with the United States Postal Service with sufficient postage as "First Class Mail" in an envelope addressed to: Mail Stop AF, Commission for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 9, 2003.

Respectfully submitted

Date: May 9, 2003

By: Brian R. Harris  
Brian R. Harris  
Reg. No. 45,900



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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**  
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**Reply to Examiner's Answer**

**Brian R. Harris**  
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**HULBERT & BERGHOFF**  
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**(312) 913-0001**



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Reply to Examiner's Answer

Sir:

The Examiner's Answer only superficially addresses the arguments in Appellant's Appeal Brief. Although the Examiner makes reference to Appellant's arguments, the corresponding discussion essentially repeats the Examiner's previous grounds of rejection with only slight changes in wording. Therefore, the discussion fails to specifically address Appellant's arguments. Although only certain deficiencies in the Examiner's Answer are highlighted in this Reply, Appellant continues to assert all arguments previously made in its Appeal Brief. And, while this Reply includes an abbreviated discussion of Appellant's arguments, Appellant notes that the full discussion can be found in the Appeal Brief.

In its Appeal Brief, Appellant explains how the Examiner has not made a prima facie case of obviousness because the Examiner has not shown any motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to combine Chen, Ikegaya and other various references in the manner asserted by the Examiner. (Appeal Brief, pg. 13). Specifically, Appellant explains how the prior art must suggest the desirability of the modification, and that the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. (Appeal Brief, pg. 13). However, the only rationale provided by the Examiner for combining these references consists of a listing of advantages that would result after the combination; it does not include any showing of where the advantages are disclosed in any of the cited references. (2nd Office Action, pg. 17; Answer, pg. 17-18). Appellant's Appeal Brief explains how these advantages are only taught on Appellant's disclosure and how using advantages only found in Appellant's disclosure against Appellant is impermissible hindsight that cannot serve as a motivation to combine the references. (Appeal Brief, pg. 15).

Specifically, Appellant explains how one consulting the Chen reference dealing with commercial printing system would not be motivated to even refer to the Ikegaya reference that discusses a single, stand-alone facsimile machine. The facsimile machine does not serve as a finishing device for a commercial printing system nor does the facsimile machine have attached finishing devices. For the same reasons, one consulting the Ikegaya reference would not be motivated to refer to the Chen reference. As the references are from different areas, there is no motivation to combine the references and the Examiner has not made a prima facie case of obviousness.

Appellant additionally explains in its Appeal Brief that the Examiner has not made a prima facie case of obviousness because the combination of references fails to teach or suggest all the limitations of any pending claim. Specifically, the references fail to teach or suggest "automatically printing an instruction sheet listing setup operations to be performed prior to completing a print job." (Appellant, claim 1). The Examiner acknowledges that neither reference teaches this limitation; rather the Examiner continues to impermissibly create this single limitation from the combination of two different references. (Answer, pg. 17). As the Examiner's Answer still fails to identify any single reference that includes this claim limitation, the Examiner has not made a prima facie case of obviousness.

The Examiner has not rebutted, and in some cases not even addressed that the Examiner has not made a prima facie case of obviousness because the references themselves do not suggest the desirability of the proposed combinations nor do they teach or suggest all elements of any pending claim. In view of the arguments presented herein and in Appellant's Appeal Brief, reversal of each and every rejection is appropriate. Appellants previously filed a Request for Oral Hearing along with the fee and continue to request that an oral hearing be scheduled before the Board of Patent Appeals and Interferences.

Respectfully submitted,

**MCDONNELL BOEHNEN  
HULBERT & BERGHOFF**

Date:

5/9/03

By:

B. R. Harris

Brian R. Harris

Registration No. 45,900